

REMARKS

Applicants appreciate the withdrawal of at least some of the rejections set forth in the previous Action.

Applicants hereby add new claims 31-35. Accordingly, claims 1-35 are pending in the present application.

Claims 21-27 stand rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1-4, 7-11, 14-19, 21-24, and 27-30 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,430,711 to Sekizawa in view of U.S. Patent NO. 6,405,178 to Manchala et al. Claims 5-6, 12-13, and 20 stand rejected under 35 USC 103(a) for obviousness over Sekizawa and Manchala in view of Official Notice (ON1). Claims 21-24 and 27 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of Manchala and further in view of Official Notice (ON2). Claims 25 and 26 stand rejected under 35 USC 103(a) for obviousness over Sekizawa in view of Manchala and ON2 and further in view of ON1.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the 103 rejection of claim 1, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2). Applicants respectfully submit that the Office has failed to establish a proper *prima facie* rejection of claim 1 for at least the following reasons.

Initially, there is no motivation to combine the teachings of Manchala with the teachings of Sekizawa and the 103 rejection of claim 1 is improper for at least this reason. More specifically, the Office states that the motivation on page 5 is to provide an alternative to fax transmission for a printer, and thereby enable a printer to transmit a purchase order via e-mail directly to a vendor and on page 6 the printer or peripheral is modified to operate within a secure computing environment as taught by Manchala, in order to communicate purchase orders directly with a vendor. Applicants respectfully submit that the alleged motivation is deficient for at least the following reasons.

Applicants refer the Office to the authority of *In re Lee* provided in the previous response regarding proper motivation to combine or modify prior art references. In particular, the Court stated that the factual question of motivation is material to patentability and **can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.** In the instant case, **the record is void of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are contrary to the reference teachings and are insufficient for proper motivation** as set forth by the Federal Circuit.

Initially, as discussed in detail below, the teachings of the references relied upon by the Office fail to disclose a printer enabled to transmit an order via email let alone a printer communicating by email directly to a vendor as alleged by the Office. Accordingly, even if the teachings are combined, the combination fails to achieve the result for which the alleged motivation was intended in the first instance and accordingly the motivation is faulty.

Further, the teachings of col. 1 of Sekizawa identified by the Office do not disclose that the printer is configured for fax transmission but rather a recorder. The Office has failed to present any evidence that motivation to modify a recorder would result in any motivation to change a communications protocol of a printer.

In addition, embodiments of Sekizawa at Figs. 1 and 2, and col. 18, line 47 - col. 20, line 17 teach that the described configuration does not directly communicate with a vendor as alleged in the motivation but rather the printers P communicate with the local information transmission means of the whole agent unit 10 external of the printers and coupled with a plurality of printers. The teachings of Sekizawa of the printers P communicating with a respective agent unit 10 and the lack of any evidence of an advantage gained by direct communication contrary to the teachings of Sekizawa illustrate the improper nature of the motivation relied upon by the Office in support of the 103 rejection.

In addition, there is no evidence cited by the Office that the systems and methods of Sekizawa are insecure and Applicants have electronically searched Sekizawa and failed to identify any teachings regarding "security." The Office has cited

no authority in support of the position that security would be increased if Sekizawa were modified. The Office has failed to identify any evidence of record that the system of Sekizawa is insecure to motivate one to look for modifications or that a system or method of increased security would result if Sekizawa were modified as alleged by the Office. The motivations identified by the Office are conclusory, subjective opinions of the Office which have not been properly supported by objective teachings of record.

Accordingly, the only motivation results from improper reliance upon Applicants' disclosure which is improper for a prima facie rejection. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office has failed to establish a proper prima facie rejection of claim 1 for at least this reason.

In addition, even if the teachings of Sekizawa and Manchala are combined as proposed by the Office, positively recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason. For example, claim 1 clearly recites determining *by a processor within a peripheral device* that an amount of a consumable has decreased below a threshold. The Office recites recorder teachings in col. 1, lines 19-35 of Sekizawa as allegedly disclosing the above-recited limitations. However, there is no disclosure in teachings relied upon by the Office of the *recorder comprising a processor within a peripheral device* as claimed. Such teachings of Sekizawa fail to disclose the above-recited limitations and the Office has failed to establish a prima facie 103 rejection for at least this reason.

In addition, claim 1 recites transmitting an email from the peripheral device to order additional supplies of the consumable. The Office on page 5 of the Action states that Sekizawa does not specifically disclose e-mail ordering but that Manchala at col. 4, lines 5-27 teaches placing purchase orders with vendors using email. Applicants respectfully assert that the combination of the teachings in col. 4 of Manchala fail to cure the deficiencies of Sekizawa.

More specifically, Applicants note that the Office taking a position that Manchala teaches a printer performing email ordering is directly opposite to the position taken by the Office in the Office Action mailed August 5, 2004. In particular, at page 5 of that Office Action, it was clearly stated by the Office that Manchala does not disclose a

printer sending an email. Further, Applicants have searched the Manchala teachings in col. 4 relied upon by the Office and have failed to uncover any teachings regarding communication of an email by a printer let alone the that a printer places an order at all. Manchala discloses at col. 4, lines 20+ the printer sending an "event" and not an email as claimed by Applicants and as alleged by the Office. To the contrary of the claim limitations regarding the transmitting the email from the peripheral device to order, Manchala discloses a "network appliance" places an order (col. 4, lines 5-7). As set forth in col. 2, lines 40+, Manchala discloses that the *network appliance receives events from the printers and places orders* and accordingly Applicants respectfully submit that such teachings regarding the network appliance reveal the network appliance is in communication with plural printers and may not be fairly interpreted to disclose a printer placing an order. The transmitting recited by Applicants in claim 1 is not disclosed nor suggested by the prior art even if the teachings of the references are combined and the Office has failed to establish a prima facie rejection of claim 1 for this additional reason.

For at least the above-mentioned reasons, Applicants respectfully submit that the Office has failed to establish a proper prima facie 103 rejection of claim 1 and claim 1 is allowable. Applicants respectfully request allowance of claim 1 in the next Action.

Applicants have identified herein claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

The claims which depend from independent claim 1 are in condition for

allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claims 5-6, the Office on page 7 alleges that it is old and well known for computer equipment and peripherals to be placed on periodic maintenance schedules. Applicants respectfully traverse the taking of Official Notice in support of the rejection and requests that the Office identify prior art in a non-final Action in support of the rejection of claims 5 and 6 if such claims are not allowed.

MPEP 2144.03A (8th ed., rev. 2) provides that *official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known*. It is not appropriate for the Office to take office notice of facts without a reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations, and not with respect to the limitations individually. Pursuant to MPEP §2144.03 (8th ed., rev. 2), Applicant hereby demands evidence with respect to what the Examiner apparently relies upon as being "well-known."

In addition, dependent claim 6 recites the *processor within the peripheral device comprises an embedded web server*. The Office on pages 5-6 recites teachings of the prior art in support of the rejection of claim 6. However, on such pages, the Office has failed to identify any prior art teachings which allegedly disclose the embedded web server limitations defined in claim 6. Claim 6 is allowable for at least this reason and Applicants respectfully request issuance of a non-final Action in accordance with the CFR if claim 6 is not allowed so Applicants may appropriately respond during the prosecution of this application.

Dependent claim 28 recites the *email is communicated directly from a peripheral device to a vendor*. Col.1 of Sekizawa is void of any teaching of a recorder being

embodied within a peripheral device. Manchala discloses printers communicating with a network appliance which places an order. The teachings of the prior art fail to disclose or suggest the limitations of claim 28 and claim 28 is allowable for at least this reason.

Referring to the 103 rejection of claim 8, Applicants submit there is no motivation to combine the teachings of Manchala with the teachings of Sekizawa and the 103 rejection of claim 8 is improper for at least this reason.

Further, independent claim 8 recites that the computer readable code is configured to cause a processor contained in a peripheral device to determine that an amount of the consumable has decreased below a predetermined threshold. The teachings in col. 1 of Sekizawa fail to disclose or suggest these limitations and the 103 rejection of claim 8 is improper for at least this reason.

Additionally, the teachings of Sekizawa and Manchala relied upon by the Office are void of any teaching or suggestion of the processor contained in the peripheral device transmits an email from the peripheral device to order supplies of a consumable.

Claim 8 is allowable for this additional reason.

Applicants respectfully request allowance of claim 8 in the next Action for at least the above-identified compelling reasons.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 103 rejection of claim 15, there is no motivation to combine the teachings of Manchala with the teachings of Sekizawa and claim 15 is allowable for at least this reason.

Applicants have failed to uncover teachings in the prior art references, even if combined, of the claimed processing circuitry which transmits an email from the peripheral device to order additional supplies of the consumable as set forth in claim 15. The Office has failed to establish a proper prima facie rejection for this reason.

Applicants respectfully request allowance of claim 15 in the next Action for at least the above-identified compelling reasons.

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the

cited art.

Referring to the 103 rejection of claim 21, there is no motivation to combine the prior art teachings and the Office has failed to establish a prima facie rejection for at least this reason.

The teachings of Sekizawa and Manchala relied upon by the Office fail to disclose or suggest the claimed instructions cause a processor to *transmit an email from a peripheral device to order additional supplies of a consumable*. Claim 21 is allowable for this additional reason.

The claims which depend from independent claim 21 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the 101 rejection of claims 21-27, Applicants respectfully request citation of authority in support of the position of the Office in accordance with the CFR. The Office alleges on page 3 of the Action that a signal is insubstantial and neither concrete nor tangible without the citation of any authority that such renders the claims non-statutory subject matter. In addition, the Office has failed to address the appropriateness of denying these specific Applicants protection of propagated signal claims when the Office has issued numerous other patents containing propagated signal claims as set forth in the previous response of Applicants. If the claims are not allowed, Applicants respectfully request citation of authority in support of the 101 rejection so Applicants may appropriately respond.

Applicants respectfully request allowance of claim 21 in the next Action for at least the above-identified compelling reasons.

Applicants hereby add new claims 31-35 which are supported by Fig. 1 and at least the specification teachings of pages 3-7 of the originally-filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert E. Haines

Mark A. Harper

By:



James D. Shaurette

Reg. No. 39,833

Date: 4/27/05